

Claims 1 to 16, and 21-43 remain to be examined in this application. Applicant hereby affirms the prior election. All other claims have been cancelled. No new subject matter has been added by the amendment made to the pending claims.

Claims 1 to 16, and 21-43 now stand rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons set out on pages 4 through 7 of the Examiner's report. These claims are now amended as required by the Examiner and full reconsideration is requested.

Claims 1, 4-9, 12-15, 21-22, 25-27, 29-31, 34-36, 39, and 42 now stand rejected under 35 USC 102(b) as being allegedly anticipated by US 5,543,616 to Giuliano et al.

Claims 2-3, 10-11, 16, 23-24, 28, 32-33, 37-38, and 43 now stand rejected under 35 USC 103(a) as being unpatentable over Giuliano et al in view of Ming-ho, or Lee, or Schunk, or Hawkins, or Volland, or Day.

Before commencing any rebuttal with reference to any alleged prior art the Examiner is respectfully directed towards the following excerpted case law from which Applicant will draw liberally.

ANTICIPATION

The following excerpts of U.S. case law represent Applicant's understanding of the test for novelty.

In Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986) ("It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention, and that such a determination is one of fact.").

In re Donohue, 766 F.2d 531, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985) ("an anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice, or device.").

It is well settled that prior art under 35 USC Section 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it Such possession is effected if one of ordinary skill in the art could have combined

the publication's description of the invention with his own knowledge to make the claimed invention Accordingly, even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it is not enabling It is not, however, necessary that an invention disclosed in the publication shall have actually been made in order to satisfy the enabling requirement.

In Atlas Powder Co. v. E.I. du Pont De Nemours & Co., 750 F.2d 1569, 1574, 224 U.S.P.Q. 209, 411 (Fed. Cir. 1984) ("exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference").

In Tights, Inc. v. Acme-McCrary Corp., 541, F.2d 1047, 191 U.S.P.Q. 305 (4th Cir. 1976); Saf-Gard Prods., Inc. v. Service Parts, Inc., 532 F.2d 1266, 190 U.S.P.Q. 455 (9th Cir. 1976); Shanklin Corp. v. Springfield Photo Mount Co., 521 F.2d 609, 187 U.S.P.Q. 129 (1st Cir. 1975) ("To anticipate under section 102, a prior art reference must disclose all the elements of the claimed invention or their equivalents functioning in essentially the same way.").

In Re Hart v. Baarcke, 186 U.S.P.Q. 275-278 (S.D. FAL. 1975) one foreign publication no matter how obscure may be sufficient to invalidate a patent claim if it clearly and definitely discloses the elements of the patents in suit.

In W. Robinson, The Law of Patents for Useful Inventions section 325-327 (1890) the publication must be 1) a work of public character, intended for general use 2) within the reach of the public. A work of public character is such a book or other printed document as is intended and employed for the communication of ideas to persons in general as distinguished from particular individuals Private communications although printed do not come under this description, whether designed for the use of single persons or of a few restricted groups of persons But though the subject of the publication may be highly technical, and therefore interesting only to a single class of individuals, it is prepared for general circulation in that class, it is a public not a private work

It must have been actually published in such a manner that anyone who chooses may avail himself of the information it contains It is not necessary that many copies of the work should have been printed, nor that its distribution should have been extensive, for the deposit of a single copy in a library to which the public have or can obtain admission places the work within the reach of all. Nor is it requisite that any person should have read or seen it, since the accessibility of knowledge, and not its actual possession, is all that any inventor can secure. And even though the information be so intermingled with discussions relative to other subjects that it may easily escape attention, and would require some skill and patience to extract it, the publication will still be sufficient.

In re Beno (1985) 768 F.2d 1340, 226 U.S.P.Q. 683 (Fed. Cir. 1985) a prior art patent or published application is a reference only for that which it teaches.

The scope of a patent's claims determines what infringes the patent; it is no measure of what it discloses. A patent discloses only that which it describes, whether specifically or in general terms, so as to convey intelligence to one capable of understanding.

Aluminum Co. of America v. Spiry Products Inc., 285 F. 2d 911, 922, 127 U.S.P.Q. 394 (6th Cir. 1960); Borg-Warner Corporation v. Mall Tool Co. 220 F. 2d 803, 805, 105 U.S.P.Q. 147 (7th Cir. 1955) a foreign patent is to be measured as anticipatory, not by what might have been made out of it, but what is clearly and definitely expressed in it. An American patent is not anticipated by a prior foreign patent, unless the latter exhibits the invention in such full, clear, and exact terms as to enable any person skilled in the art to practice it without the necessity of making experiments.

In *re* Mortin (1961) 288 F.2d 708, 711, 129 U.S.P.Q. 227 (C.C.P.A. 1961) the state of the art does not depend on the provincial view that the available knowledge is only that published in one locality or contained only in domestic patents. Appellant . . . attempts to disparage the value of the French patent as a reference on the ground that it is a foreign patent and is good for only what it clearly and definitely discloses. That statement is true with respect to any reference, patent or otherwise, foreign or domestic. There is no basis in the statute . . . for discriminating either in favour of or against prior art references on the basis of nationality. We do know that some opinions have looked askance at foreign patent, but that it is for the reason that the patents of some countries have been notorious for containing inadequate and incomplete disclosure.

In re Sun, 31 USPQ 2d 1451, 1453 (Fed. Cir. 1993) (unpublished)

Under section 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim. . . .

But to be prior art under section 102(b), a reference must be enabling. . . . That is, it must put the claimed invention in the hand of one skilled in the art. . . . The examiner bears the burden of presenting at least a prima facie case of anticipation.

Helifix Ltd. v. Blok-Lok, Ltd., 54 USPQ 2d 1299, 1304 (Fed. Cir. 2000)

"[E]ven if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling." *Donohoe*, 766 F.2d at 533, 226 USPQ at 621.

In re Wilder, 166 USPQ 545, 548 (C.C.P.A. 1970)

Simply stated, a prior publication or patent description will be considered as anticipatory when its disclosure is at once specific and enabling with regard to the particular subject matter at issue. . . . However, such disclosure may yet be held not

to legally anticipate the claimed subject matter if it is found not to be sufficiently enabling, in other words, if it does not place the subject matter of the claims within "the possession of the public."

Ciba-Geigy Corp. v. Alza Corp., 37 USPQ 2d 1337, 1341 n.3 (Fed. Cir. 1995) (unpublished)

An anticipatory reference must be enabling, *see Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479, 1 U.S.P.Q.2D (BNA) 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909, 96 L. Ed. 2d 382, 107 S. Ct. 2490 (1987), so as to place one of ordinary skill in possession of the claimed invention. *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2D (BNA) 1655, 1657 (Fed. Cir. 1990); *see Seymour v. Osborne*, 78 U.S. 516, 555, 20 L. Ed. 33 (1870) ("The knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention.").

OBVIOUSNESS

The traditional test enunciated in *Graham vs. John Deere Company* 383 U.S. 1, 148 U.S.P.Q. 459 1966, for Section 103 nonobviousness requires the fact finder to make several determinations. The test provides that the scope and content of the prior art be determined, the differences between the prior art and the claims at issue be ascertained, and the level of ordinary skill in the pertinent art be resolved. Thus, the patentability of the claims at hand must stem from the fact that the specific combination of the claimed elements was not disclosed in the prior art and the additional allegation that the specific combination of claimed elements was nonobvious to one of ordinary skill in the art.

Clearly, the prior art does not suggest or provide any reason or motivation to make such a modification as purported by the Examiner. With reference to *In Re: Regal*, 526 F. 2d 1399, 1403 n. 6, 188 USPQ 136, 139 n. 6 (CCPA 1975).

"There must be some logical reason apparent from positive, concrete evidence of record which justifies a combination of primary and secondary references".

In Re: Geiger, 815 F. 2d 686, 688, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987) (obviousness can not be established by combining pieces of prior art absent some "teachings, suggestion, or incentive supporting the combination"); *In Re: Cho*, 813 F. 2d 378, 382, 1 USPQ 2d 1662, 1664 (Fed. Cir. 1987) ("discussing the Board's holding that the artisan would have been motivated to combine the references").

Therefore, it Applicant's view there is no evidence of motivation in the prior art, either within the references themselves, or knowledge generally available to one of ordinary skill in the art, to make the purported changes suggested by the Examiner to arrive at the claimed subject matter.

Respectfully, the Examiner is creating a 20/20 hindsight reconstruction using Applicant's invention as a blue print to allegedly find elements of Applicant's combination in the prior art. This is not permissible as set out below.

In re Oetiker, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992)

The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. (emphasis added) That knowledge can not come from the applicant's invention itself.

ATD Corporation v. Lydall, Inc., 48 USPQ 2d 1321, 1329 (Fed. Cir. 1998)

Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor. (emphasis added)

In Re: Fritch, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992)

"Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board. Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious (emphasis added). The court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In Re: Rouffet, 47 U.S.P.Q. 2d 1453 (Fed. Cir. 1998)

"As this court has stated, "virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for

*piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).*

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. (emphasis added)

This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. In this case, the Board relied upon none of these. Rather, just as it relied on this high level of skill in the art to overcome the differences between the claimed invention and the selected elements in the references, it relied upon the high level of skill in the art to provide the necessary motivation. The Board did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Instead, the Board merely invoked the high level of skill in the field of art. If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

*Because the Board did not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of Rouffet's invention to make the combination, this court infers that the examiner selected these references with the assistance of hindsight. This court forbids the use of hindsight in the selection of references that comprise the case of obviousness. (emphasis added) See *In re Gorman*, 933 F.2d 982, 986, 18 USPQ 2d 1885, 1888 (Fed. Cir. 1991). Lacking a motivation to combine references, the Board did not show a proper prima facie case of obviousness. This court reverses the rejection over the combination of King, Rosen and Ruddy."*

In re Geisler, 43 USPQ 2d 1362, 1365 (Fed. Cir. 1997)

Addressing a case similar in some respects to this one, the Court of Customs and Patent Appeals stated that a prima facie case of obviousness can be rebutted if the applicant (1) can establish "the existence of unexpected properties in the range claimed" or (2) can show "that the art in any material respect taught away" from the

claimed invention. . . . As this court has explained, "[o]ne way for a patent applicant to rebut a prima facie case of obviousness is to make a showing of 'unexpected results,' i.e., to show that the claimed invention exhibits some superior property or advantage that a person of ordinary skill in the relevant art would have found surprising or unexpected." *In re Soni*, 54 F.3d 746, 750, 34 USPQ 2d 1684, 1687 (Fed. Cir. 1995). When an applicant seeks to overcome a prima facie case of obviousness by showing improved performance in a range that is within or overlaps with a range disclosed in the prior art, the applicant must "show that the [claimed] range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ 2d 1934, 1936 (Fed. Cir. 1990).

Under that standard, "it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Only if the "results of optimizing a variable" are "unexpectedly good" can a patent be obtained for the claimed critical range. *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); see also *In re Dillon*, 919 F.2d 688, 692, 16 USPQ 2d 1897, 1901 (Fed. Cir. 1990) (in banc). Furthermore, it is well settled that unexpected results must be established by factual evidence. "Mere argument or conclusory statements in the specification does not suffice." *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1994).

Referring now to United States Patent 5,473,616 to Giuliano hereinafter referred to as '616 there is taught an image display of one or more thin integrated panels having an LED embedded in the edge thereof and including an image being scratched or etched with a display. As taught at Column 2 of the disclosure of the '616 patent the panels are thin and the overall display may include coloured LED's or translucent panels. However, at no time does the '616 patent to Giuliano teach an ornament. The present amendment of Claim 1-7, 12-16, 21-28, 31-33, 36-38 and 42 have been limited to an ornament only. It is submitted according to accepted jurisprudence précised above, that for reference to anticipating it must describe each and every element of the invention. In this regard see *In Re: Donahue*. Exclusion of claimed elements from a prior art reference is enough to negate anticipation by that reference.

It is therefore respectively submitted that the above-mentioned list of claims specifically referring to an ornament are not anticipated by '616 reference.

Further it is surmised that the Examiner may allege an obviousness rejection on the same grounds. However for any surmised obviousness rejection Graham and John Deere, précised above, must be referred to and on would conclude that there is significant difference between the '616 reference and the claims at issue since '616 reference does not directly teach nor infer the combination of the claimed elements described in the above-mentioned list of claims for an ornament. Further there is no motivation within the '616 reference to manufacture an ornament from the teachings of '616. There is no reason, suggestion or

motivation found in the '616 reference whereby a person of ordinary skilled in the art would arrive at the invention of an ornament.

To do so following the Examiner's arguments and allegations would require 20/20 hindsight which is not permissible. For example, In Re: Fritch it was held impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious.

Referring now to the Examiner's anticipation arguments which respect to Claim 8, 9, 29, 34, 35, 39, 40, 41 and 43, it is again reiterated that for the same reasons set out above in relation to the claims related to ornaments, that should the prior art lack one aspect of the invention that it cannot be considered to be anticipatory. The Examiner is referred to the references for example in Re: Donahue or the like cited above in this regard.

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Applicant therefore has carefully amended the claims set with reference to the display signs to include limitations not found in the '616 reference. For example the limitations of Claim 10 and 11 have been included in to independent Claim 8 with Claims 10 and 11 being cancelled. It is submitted that the '616 reference does not teach the LED array being disposed on a printed circuit board which is housed between the rails of the housing and wherein the sign is sized to fit between the pair of supporting rails. These limitations in Claim 8 are clearly not taught in the '616 reference and therefore it must be dismissed as an anticipatory reference.

Further with respect to Claim 29 the same issues are present and that is that the limitation of Claim 30 has now been provided with Claim 29 and a light sources are disposed within a module including a printed circuit board for powering a light source. This is clearly not taught in the '616 reference and therefore again it must be refused as an anticipatory reference and set aside.

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Claims 34 and 35 now include the limitations of old Claim 31. Claim 34 includes the limitation of the use of the sign as a display sign for a store window. This display sign is not taught in the '616 reference since it really teaches artistic impressions. There is no discussion of display signs whatsoever in the reference. Similarly Claim 35 now includes the limitation that the sign is for emergency purposes which is a functional purpose unlike that of the '616 reference. Clearly therefore these limitations in Claims 34 and 35 set apart and identify a substantial difference between those claims and the '616 reference. It is axiomatic that each and every element of the claim must be present for a reference to anticipate. This is a well accepted conclusion in patent practice.

It is therefore assumed that the claims depending on the independent Claims 8, 29, 34 and 35 which relate to display signs would also be allowable since they would include the limitations of the four mentioned independent claims.

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Should the Examiner allege an obviousness issue in this regard for these display signs it is submitted that all of the new limitations of Claims 8, 29, 34 and 35 are not taught nor inferred directly or indirectly in the '616 reference or is there any motivation in that reference to arrive at Applicant's invention. Again following Graham and John Deere Applicant has set out the differences between the prior art '616 and the claims at issue for the display sign and full and reconsideration is respectfully requested.

With regard to the Examiner's obviousness rejections with respect to the '616 reference as a primary reference it is respectfully submitted that all the claims have now been amended to identify over the '616 reference and any combination that the Examiner may put forward with respect to various patents cited on page 9 of her report.

For example, the Examiner has alleged that Claims 2 and 3 are obvious in view of '616 and Ming Ho stating that Ming Ho at column 14 teaches displays of Santa Claus, crucifix or a heart. If the Examiner will read that particular section specified in Ming Ho there is clearly no reference to Santa Claus, crucifix or hearts at specific lines 37 to 53. What is stated is toys, gift items, decorations, pins, buttons, badges, ornaments and the like. It is respectfully submitted then that Ming Ho does not teach Christmas ornaments as in required in Claim 2 nor Santa Claus, crucifix or a heart as required by Claim 3. Further it is submitted that when reading the '616 reference one skilled in the art would not apply the teachings or combine the teachings of the Ming Ho reference since the teachings thereof are not readily combinable. Ming Ho teaches greeting cards and plaques which are flat and planar. The lighting thereof is internal and there is no possibility of combining that with the lighting of the '616 reference.

The limitation of Claims 10 and 11 have now been incorporated into Claim 8 which the Examiner did not reject on the basis of Section 103. Out of an abundance of caution Applicant therefore has amended Claim 8 to further include limitations of Claim 10 and 11. Clearly the combination of a revised Claim 8 is not obvious to those skilled in the art in view of the '616 reference and the '983 Lee reference. Since the sign of Applicant's invention is sized to sit between the pair of supporting rails and further one of the rails carries light emitting diodes provided with a printed circuit board. To modify the teachings of '616 with the teachings of Lee would require an excessive amount of skill to one ordinary skill in the art where in the motivation to do so is lacking from the '616 reference. In fact the Lee emergency exit light is classified both in the international and U. S. class system in different classes. One reading '616 would not look to the teachings of the Lee reference for an emergency exit light for modification of 616.

Referring now to Voland, U. S. 4,965,701, there is nothing within the teachings of Voland that would teach a string of ornaments. Clearly Voland teaches a curtain kit wherein the curtain is suspended as a series of parallel light ropes as seen in Figure 3 including a string of lights extending from a horizontal member in Figure 8 utilized as illumination for divider curtains for the interior of a dwelling.

The teachings of Voland include a supporting member wherein the strings of the light members extend from. Clearly an illumination curtain kit including bulbs is not the same things as an ornament. One skilled in the art of manufacturing ornaments would not look to the teachings of this reference to curtains to separate two rooms, for example, in a dwelling. Therefore this reference cannot be readily combined with the '616 to arrive at the teachings of Claims 16, 23, 24, 28 and 32 now amended. It is submitted that the dependant claims include the limitations of the independent claims from which they depend and these are clearly not taught in the Voland reference or any combination of the '616 and Voland reference. How therefore might a conclusion of obviousness be arrived at?

The Examiner then combines the teachings of Day with the '616 reference referring to the aspect of toys and necklaces. Again it is not the dependant claim that is being claimed on its own but in combination with the independent claims which identify over the prior art clearly.

The Examiner continues her 20/20 hindsight reconstruction by attempting to combine '616 with Ming Ho with respect to illuminated toys and again Claim 43 as well.

Respectively the Examiner is clearly creating a 20/20 hindsight reconstruction. This is not permitted and in fact with the additional case law cited in this response in Re: Fritch it is not permissible to use the claimed invention as an instruction manual or template to piece together the teachings of prior art so that the claimed invention is rendered obvious. This is a 20/20 hindsight construction and the efforts of the Examiner to do so are clear. Picking and choosing references from the prior art and combining it with a reference that does not teach for example ornaments nor Applicant's invention as specified in the amended claims is not permissible.

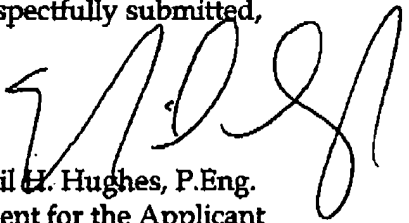
As specified in Re: Rouffet the court requires the Examiner to show a motivation to combine the references to create the case of obviousness. The Examiner must show reasons that the skilled artisan confronted with the same problem as the Applicant with no knowledge of the claimed invention would select the elements from the cited prior art references for combination in the matter claimed.

It is therefore requested that the Examiner withdraw her obviousness rejection of the claims indicated in her report of March 19, 2003 and that full reconsideration be given to the amended claim set in view of those amendments and the arguments presented above.

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If the Examiner has any questions, the Examiner is respectfully requested to contact Neil H. Hughes at (905) 771-6414 collect at his/her convenience.

Respectfully submitted,



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